

REMARKS

This response is submitted in response to the Final Office Action mailed August 22, 2005 to request reconsideration of the rejection of claims 1-3 and 8-15 as set forth therein. In the event the Examiner determines that the foregoing amendments do not place the case in condition for allowance, it is respectfully requested that the above amendments be entered to place the claims in better form for consideration on appeal.

In the Final Office Action, the Examiner again objects to the specification alleging that the incorporation of essential material in the specification by reference to a foreign application or patent is improper. Applicants reiterate their response in the previous response that the incorporation of the foreign priority document is proper and know of no authority otherwise. In this regard, the Examiner cites MPEP 608.01(p) to support his position.

Applicant respectfully submits that MPEP 608.01(p) actually supports Applicant's position that the incorporation by reference of the priority document is proper. Sub-part B of MPEP 608.01(p) recites in part:

As a safeguard against the omission of a portion of a prior application for which priority is claimed under 35 U.S.C. 119(a)-(d) or (f), or for which benefit is claimed under 35 U.S.C. 119(e) or 120, applicant may include a statement at the time of filing of the later application incorporating by reference the prior application.

The same section also refers to MPEP 201.13, in which sub-part G recites in part:

Applicant may incorporate by reference the foreign priority application by including a statement in the U.S. application-as-filed that such specifically enumerated foreign priority application is "hereby incorporated by reference."

Therefore, it is clear from the MPEP that such incorporation by reference is proper. Accordingly, the Examiner is respectfully requested to withdraw the objection to the specification.

In the Final Official Action, the Examiner rejects claims 10, 11, and 15 under both 35 U.S.C. § 112, first and second paragraphs. The Examiner's rejections both relate to the addition of the term "minimum" to describe the bend radius of the other portions of the insertion section.

Although Applicant does not agree with the Examiner that such term is not taught in the specification (35 U.S.C. § 112, first paragraph) or that it is indefinite (35 U.S.C. § 112, second paragraph), in order to advance prosecution, claims 10, 11, and 15 have been amended to remove the term "minimum." Therefore, claims 10, 11, and 15 have been amended to refer to "a bend radius of other portions of the insertion member."

Accordingly, it is respectfully requested that the rejection of claims 10, 11, and 15 under 35 U.S.C. § 112, first and second paragraphs, be withdrawn.

In the Final Office Action, the Examiner rejects Claims 1-3, 8-12 and 14-15 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,759,490 to Malchesky (hereinafter "Malchesky") in view of U.S. Patent No. 6,361,751 to Hight, III (hereinafter "Hight"). Additionally, the Examiner rejects claims 1-3, 8-12 and 14-15 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,534,221 to Hillebrenner et al. (hereinafter "Hillebrenner") in view of Hight. Furthermore, the Examiner rejects claim 13 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Malchesky and Hight, and further in view of U.S. Patent No. 3,633,758 to Morse et al. (hereinafter

“Morse”). Lastly, the Examiner rejects claim 13 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hillebrenner and Hight, and further in view of Morse.

In response, Applicant respectfully traverses the Examiner’s rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, as discussed below in section II, in order to advance prosecution, independent claims 1, 9, 10, 11, and 15 have been amended to clarify their distinguishing features.

I. THERE IS NO MOTIVATION OR SUGGESTION TO COMBINE EITHER MALCHESKY OR HILLEBRENNER WITH HIGHT

Firstly, Applicant respectfully submits that there is no motivation or suggestion to combine either Malchesky or Hillebrenner with Hight. Hight teaches from column 1, line 47 to column 2, line 9 that one of the known endoscope disinfection apparatus is a box shaped soaking basin with lids. Hight goes on to teach that such basins have their disadvantages, such as requiring a large amount of disinfectant and having a large surface area of disinfectant in contact with the air. Thus, Hight teaches away from the use of basin type apparatus for endoscope sterilization and those skilled in the art would not be motivated to combine the teachings thereof with the basin type apparatus in either Malchesky or Hillebrenner (A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir., 1983), *cert. denied*, 469 U.S. 851 (1984)).

For at least these reasons, Applicant respectfully submits that the combinations of Malchesky with Hight and Hillebrenner with Hight are improper and must be withdrawn.

II. INDEPENDENT CLAIMS 1, 9, 10, 11, AND 15 PATENTABLY DISTINGUISH OVER THE CITED REFERENCES

Secondly, Hight discloses a device in which a liquid medicine is stored and an endoscope is immersed, thereby to disinfect the endoscope. That is to say, the container

taught by Hight is not the one which is to be put in a high-pressure sterilizing device. Thus, the size or shape of the container itself is not subject to any restriction, i.e., the endoscope is not subject to any restriction when it is put in the container. Hence, the invention of Hight is distinguished from the present invention as recited in the claims in which the insertion member has to be in part bent.

Hillebrenner discloses a device to sterilize an endoscope. In the device of Hillebrenner, the insertion portion of the endoscope is merely rounded. In other words, the device of Hillebrenner is not the one to locate the endoscope while suppressing bending of the insertion portion as in the present invention as recited in the claims.

Malchesky discloses a device to sterilize a catheter. Then, a mechanism to hold the catheter in a predetermined shape is disclosed in this device. However, in this device, Malchesky pays no attention to holding so as to relax the bending of a distal 70 cm of the insertion portion.

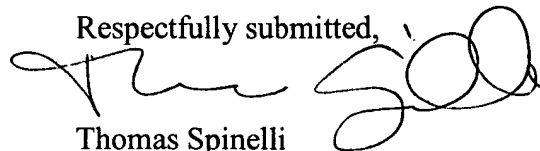
Morse discloses a rack for holding a catheter in a straight status or in a bent status. However, in the device of Morse, almost all of the catheter except the proximal side thereof is held in a bent state. Hence, Morse pays no attention to holding so as to relax the bending of a distal 70 cm of the insertion portion.

In order to clarify the above distinguishing features, independent claims 1, 9, 10, 11, and 15 have been amended to recite that the endoscope container is "stored in a high-pressure sterilizing device." The amendment to claims 1, 9, 10, 11, and 15 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment.

Independent claims 1, 9, 10, 11, and 15, as amended, are not rendered obvious by the cited references because neither the Hight patent, the Hillebrenner patent, the Malchesky patent, nor the Morse patent, whether taken alone or in combination, teach or suggest an endoscope container for high pressure steam sterilization having the features discussed above. Accordingly, claims 1, 9, 10, 11, and 15, as amended, patentably distinguish over the prior art and are allowable. Claims 2, 3, 8, 12 and 13, being dependent upon claims 1 and 11 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 1-3 and 8-15 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', is written over the typed name.

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